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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,622	12/21/2000	Curtis Cole	JBP-534	7817

7590

03/22/2002

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/742,622

Applicant(s)

COLE ET AL.

Examiner

Gina C. Yu

Art Unit

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 8, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Response and Supplemental Information Disclosure Statement filed on January 08, 2002. Claims 1-23 are pending. Claim rejections are maintained for reasons of record found in the previous office action dated June 20, 2001, and as further explained in this action.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-6, 9-11, 13-17, 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu et al. (US 4197316) ("Yu").

The rejection is maintained for reasons of record as indicated in the previous office action dated June 20, 2001.

2. Claims 1-6, 9-11, 13-17, 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Scott et al. (US 4234599) ("Van Scott").

The rejection is maintained for reasons of record.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 7, 8, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu as applied to claims 1-6, 9-11, 13-17, 21 – 23 above, and further in view of Znaiden et al. (U.S. Pat. No. 5,523,090) (“Znaiden”).

Rejection is maintained for reasons of record.

2. Claims 7, 8, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Scott, as applied to claims 1-6, 9-11, 13-17, 20.– 23 above, and further in view of Yu and Znaiden.

Rejection is maintained for reasons of record.

3. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu and Znaiden, or alternatively over Van Scott, Yu, and Znaiden, as applied to claims 1-11, and 13-23 above, and further in view of Quan et al (U.S. Pat. No. 6,180,133 B1) (“Quan”).

Rejection is maintained for reasons of record.

Double Patenting

Claims 1-11 and 13-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-7, 10-12, and 14-16 of copending Application No. 09/677,737. As stated in the previous action, although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to skin care products comprising same chemical compositions, which necessarily have same properties.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed in response to office action dated June 20, 2001 have been fully considered but they are not persuasive.

1. Rejections 35 U.S.C. § 102 in view of Yu

Applicants argue that Yu's disclosure does not anticipate the present invention which is directed to methods of improving skin firmness and the appearance of facial contours, and to reduce the appearance of sagging skin. Specifically, applicants argue that, the invention disclosed in Yu is limited to method of treating dry skin with a composition which otherwise meets the present claims.

Examiner respectfully disagrees. Applicants' claims are directed to the known topical composition in which the components are present in the amount which overlaps with the disclosure in Yu. Examiner takes the position that the claimed properties of the known composition are necessarily present in the prior art. See MPEP § 2112; In re Spada, 911 F.2d 705, 709, 15 U.S.P.Q. 1655, 1658 (Fed. Cir. 1990) (holding that physically same compositions must have the same properties).

2. Rejections under 35 U.S.C. § 102 in view of Van Scott

Similarly, applicants argue that Van Scott fails to teach that its composition can be used for claimed methods in the instant application. Examiner again takes the position that the compositions of Van Scott and instant invention, which have identical or overlapping chemical composition, must have same properties.

3. Rejections under 35 U.S.C. § 103 over Yu in view of Znaiden

Applicants argue that Znaiden's teaching of alpha hydroxy acids is limited to improving skin penetration of the xanthine. Applicants further assert that there is no teaching or suggestion that the prior art composition could be used in the claimed methods in the instant invention.

Examiner respectfully disagrees. Znaiden's invention is directed to cellulite treatment, which is to improve skin strength and firmness. See abstract. It would have been obvious to one of ordinary skill in the art to look to the prior art such as Znaiden for ingredients for skin firming compositions. The fact that the alpha hydroxide acids in Znaiden are used improve the penetration of xanthine does not necessarily negate the obviousness employing alpha hydroxide acids would render the beneficial dermatological properties such as treating dry, wrinkled, and aged skin. See col. 2, lines 13 – 20. It would have been obvious that a routineer would have combined Yu and Znaiden in expectation of producing an enhanced skin care products for such skin conditions. Furthermore, examiner notes that applicants present no unexpected property of the combination of these well-known cosmetic and dermatological components. See MPEP § 716.02 (a).

4. Rejection under 35 U.S.C. § 103 over Van Scott in view of Yu and Znaiden

Applicants state that each of the references fail to teach or suggest that the compounds in the present claims could be used in the methods of improving skin firmness and the appearance of facial contours, and to reduce the appearance of sagging skin. Examiner respectfully disagrees as explained above. Furthermore, this argument is against the references individually. One cannot show nonobviousness by

attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5. Rejection under 35 U.S.C. § 103 over Yu in view of Znaiden, or alternatively, over Van Scott in view of Yu and Znaiden, and further in view of Quan.

Similarly, applicants argue that Quan does not cure the deficiencies of the either set of combined references, and notes that Quan involves to methods for treating wrinkles. Examiner respectfully disagrees for the above stated reasons. Also, examiner views that a routineer who is in search of treatment for sagging skin would have obviously motivated to use the patch material for wrinkle treatment in Quan. Improvement of facial contour would have been an obvious result of the treatment.

6. Double Patenting Rejection

For response to applicants' argument, see above rejection.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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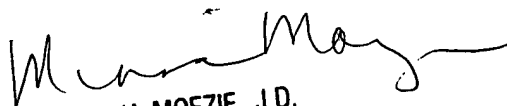
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
March 18, 2002


MINNA MOEZIE, J.D.
SUPERVISORY PATENT EXAMINER
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